

Section III:
AMENDMENT UNDER 37 CFR §1.121 to the
DRAWINGS

No amendments or changes to the Drawings are proposed.

Section IV:
AMENDMENT UNDER 37 CFR §1.121
REMARKS

Request for Telephone Interview

Applicant requests a telephone interview with the examiner following receipt of the present reply and amendment in order to answer any questions the examiner may have, and to consider any suggestions the examiner may offer. Applicant's agent, Robert H. Frantz, can be reached at 405-812-5613, by the examiner to indicate the examiner's choice of time and date for the telephone interview.

Defective Declaration

In the Office Action, the declaration was deemed defective for reason of containing uninitialed changes. Applicants presume this refers to the modified address for Anh Tuan Dang. Whereas the affirmed statements of the declaration are not affected by the modified address, applicants submit herewith a supplemental Application Data Sheet in order to clarify the address for Anh Tuan Dang (MPEP 602.01).

Rejections under 35 U.S.C. §103

In the Office Action, claims 1 - 24 were rejected under 35 U.S.C. §103(a) as being unpatentable over US Patent 6,493,340 to Kawanaka (hereinafter "Kawanaka"), in view of US published patent application 2003/0021272 to Celebioglu *et al.* (hereinafter "Celebioglu").

Our invention provides an enhanced report which allows a system administrator to determine the source of duplicate MAC addresses by identifying and reporting the IP address encapsulated within the packet. Normally, typical systems merely report the duplicated MAC address, but do not report the encapsulated (e.g. second protocol) source address.

Kawanaka reports the first protocol address when it is detected as being duplicated (e.g. the duplicated MAC address), but does not teach reporting the second protocol address, as reasoned in the Office Action. However, it was reasoned in the Office Action that Celebioglu teaches extracting the second protocol address (e.g. the IP source address), but it was not established in the Office Action where Kawanaka or Celebioglu teaches or suggests *reporting*

the second network source address.

First, considering the teachings of Kawanaka, their flow diagrams show only reporting an address if it is duplicated (see steps S9 and S14 in figs. 4 and 5). There is no suggestion by Kawanaka either (a) to *report* a second network address which is encapsulated in the data payload of the first protocol, nor (b) to report any non-duplicated addresses (e.g. report all second protocol source addresses). If one were to apply Kawanaka's methods to the first protocol (e.g. MAC) and the second protocol (e.g. IP) addresses, it would only report the second protocol addresses *only if they were also determined to be duplicated*. This would not be helpful to a system administrator trying to solve the problem the applicants have set forth.

So, one must look to Celebioglu's disclosure to find some teaching or suggestion to *report* the second protocol source address. However, Celebioglu's disclosure is directed towards, and limited to, teachings regarding "indications" of the protocols used. Their indications are binary indicators, such as LEDs or lamps, which are "activated" when a protocol is detected in a data stream or source. Celebioglu is silent as to reporting a source address value, whether it be for a first, second, or subsequent protocol.

Applicant requests withdrawal of the rejections, entry of the amendment, and allowance of the claims on the following bases of law, policy, and procedure:

1. The references do not recognize, teach or suggest *the problem(s)* discovered by the applicants and solved by the claimed invention, and as such a *prima facie* case of obviousness has not been established. An invention may be patentable due to the discovery or identification of the problem by the inventor(s), regardless of the seeming "obviousness" of the solution to the problem disclosed by the invention, as was held by the CCPA:

It should not be necessary for this court to point out that a patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the "subject matter as a whole" which should always be considered in determining the obviousness of an invention under 35 U.S.C. 103. *In re Nomiya*, 509 F.2d 566, 184 USPQ 607, 612 (C.C.P.A. 1975) (quoting *In re Sponnoble*, 405 F.2d 578, 585, 160 USPQ 237, 243 (C.C.P.A. 1969))

Further, the CCPA has held that those skilled in the art at the time of the invention would need to have knowledge of the applicant's discovery in order to know what to program a computer to do, otherwise the invention would not be obvious:

... Perhaps today, after reading appellants' disclosure, the public dissemination of which the patent system fosters and encourages, it might be obvious to program a general-purpose digital computer to practice the invention. But 35 U.S.C. 103 requires an analysis of the prior art at the time the invention was made to determine whether the invention was obvious Assuming the existence, at the time of the invention, of general-purpose digital computers as well as typical programming techniques therefor, it is nevertheless plain that appellants' invention ... was not obvious under 35 U.S.C. 103 because one not having knowledge of appellants' discovery simply would not know what to program the computer to do. *In re Prater*, 415 F.2d 1393, 162 USPQ 541.

Based on the foregoing facts, Kawanaka in view of Celebioglu fail to recognize the problem of determining the source of production of packets having duplicated first protocol addresses by determining and reporting a second source address encapsulated by the first protocol.

2. The claims include steps, elements, or limitations not taught by the references, and thus fails to support a rejection under MPEP §2143.03, which states:

All Claim Limitations Must Be Taught or Suggested. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.

In claims 1, 9 and 17, applicants have claimed reporting of the first protocol source address and a second protocol source address responsive to the first address being detected as a duplicate, without restriction to the second address being a duplicate. Kawanaka teaches only reporting a duplicated first protocol address (not a second protocol address and not an

unduplicated address). Celebioglu teaches only indicators of the protocol detected, and does not teach reporting of any addresses. Therefore, Kawanaka in view of Celebioglu fails to teach all of the claimed steps, elements, and limitations.

3. Motivation for making the proposed combination is not provided by the cited references, and thus a *prima facie* case of obviousness has not been established, whereas MPEP §2143.01 states:

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

It is only a first requirement that both references be from the same art. But, even when both references are from the same art, there still must be some suggestion by one or both of the references to make the combination or modification as proposed for the §103 rejection.

While Kawanaka and Celebioglu both make mention of the well-known OSI layered structure, Kawanaka makes no suggestion of applying their process or method to protocols which are encapsulated in a first layer or first protocol. Celebioglu recognizes that protocols can be encapsulated within each other, and teaches methods to detect and indicate which protocols are present, but Celebioglu does not suggest further modifications or combination of their device with some sort of address reporting tool, such as that of Kawanaka.

Therefore, no motivation to combine Kawanak and Celebioglu is found in the references, and no *prima facie* case of obviousness has been established.

For the foregoing reasons, Applicants request withdrawal of all rejections and allowance of claims 1 - 24.

Respectfully,

/ Robert Frantz /

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